



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/812,789	03/29/2004	Grant James Ryan	12000057-0002-002	4225

26263

7590

11/06/2009

SONNENSCHN NATH & ROSENTHAL LLP

P.O. BOX 061080

WACKER DRIVE STATION, WILLIS TOWER

CHICAGO, IL 60606-1080

EXAMINER

ENG, DAVID Y

ART UNIT

PAPER NUMBER

2455

MAIL DATE

DELIVERY MODE

11/06/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/812,789

Applicant(s)

RYAN ET AL.

Examiner

DAVID Y. ENG

Art Unit

2455

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 October 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 30, 34, 43, 45, 48-50, 91-93, 97, 98 and 121-131 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 97, 30, 34, 43, 45, 48-50, 91-93, 98 and 121-131 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-848)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

In response to the restriction requirement, Applicants elected to prosecute Group III, claims 30, 34, 43, 45, 48-50, 91-93, 97 and 98 without traverse.

Claims 1-29, 31-33, 35-42, 44, 46-47, 51-90, 94-96, 99-120 have been cancelled. Newly submitted claims 121-131 have been entered. The active claims are 30, 34, 43, 45, 48-50, 91-93, 97, 98 and 121-131 of which claim 97 is independent.

Specification

Applicants are requested to submit a new title, a new abstract and a new summary of the invention which are directed to the elected invention.

Claim Rejections - 35 USC § 112, 1st paragraph

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 97, 30, 34, 43, 45, 48-50, 91-93, 98 and 121-131 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The claims recite that the claimed social network system can perform numerous expected functions as set forth in the claims by simply configuring the social network

system. The specification fails to disclose how to configure a social network system having only a host computer and a database accessible via a data network such that the expected functions of the social network system as recited in the rejected claims can be implemented.

Claim Rejections - 35 USC § 112, 2nd paragraph

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 97, 30, 34, 43, 45, 48-50, 91-93, 98 and 121-131 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In line 7 of claim 97, for proper antecedent basis, "each said user entity" should be "said at least one user entity".

The term "said system" in line 6 of claim 97 should be "said social network system" if it is intended to refer to the social network system.

Implementation of the applications is vague and indefinite. It is not clear what the users are allowed to do by the applications such that users are able to social over the social network system.

Scope of claims 121 and 122 is not clear. Claim 121 and 122 which are process claims are improperly dependent on claim 97 which is apparatus claim.

Claim Rejections - 35 USC § 112, 2nd paragraph, omitted element

Claims 97, 30, 34, 43, 45, 48-50, 91-93, 98 and 121-131 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential elements, such omission amounting to a gap between the elements. See MPEP § 2172.01.

Independent claim 97 fails to recite components or elements to support the functions of the claimed social network system as expected in the two "wherein clauses". The preamble of claim 97 calls for a social network system as Applicants' invention. The claim combination recites that the social network system comprises only two components, namely, a host computer processor and a database accessible via a data network. In the two "wherein clauses", the social network system is expected to provide numerous functions. However, the two components as recited could not render the social network system to provide those expected functions. Dependent claims have similar defects.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 97, 30, 34, 43, 45, 48-50, 91-93, 98 and 121-131 are rejected under 35 U.S.C. 102(e) as being anticipated by Robertson (USP 6,269,369).

See Figure 5 and the corresponding description in Robertson. Robertson teaches:

Claim 97

See Figure 5 in Robertson. Robertson teaches:
a host computer processor (server 330 or CPU 332),
a database 340 accessible over a data network 360 and
input data from a plurality of data input devices (client computers) 370.

Claims 97, 30, 34, 43, 45, 48-50, 91-93, 98 and 121-131

As to the expected functions set forth in the wherein-clauses of the rejected claims, the court held that claims directed to apparatus must be distinguished from the prior art in terms of structure rather than function. *In re Danly*; 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). “[Apparatus claims cover what a device is, not what a device does.” *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990). A claim containing a “recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus” if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ2d 1647. See MPEP 2114.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DAVID Y. ENG whose telephone number is 571-272-3984. The examiner can normally be reached on M-F from 8AM to 3PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, SALEH NAJJAR, can be reached on 571-272-4006. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/DAVID Y. ENG/
Primary Examiner, Art Unit 2455